

19 JUN 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Carolyn A. Fischer
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

In re Application of
YODA, et al.

Serial No.: 10/538,450

PCT No.: PCT/US03/39866

Int. Filing Date: 15 December 2003

Priority Date: 08 January 2003

Atty Docket No.: 58343US005

For: FLEXIBLE MOLD FOR A BACK SURFACE
PLATE OF PLASMA DISPLAY PANEL (PDP)
AND PROTECTION METHODS OF THE MOLD
AND BACK SURFACE PLATE

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's petition under 37 CFR 1.47(a) filed 16 December 2005 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Chikafumi Yokoyama.

BACKGROUND

On 15 December 2003, applicant filed international application PCT/US03/39866 which claimed priority to a previous application filed 08 January 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 08 July 2005.

On 10 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and an Information Disclosure Statement.

On 16 November 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 16 December 2005, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Chikafumi Yokoyama.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

Regarding item (1), applicant is advised that pursuant to 37 CFR 1.17(g) the petition fee is \$200.00. As authorized, the petition fee will be deducted from deposit account no.: 13-3723.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." 409.03(d) also states that:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.

In the present case, counsel states that she sent a copy of the application, an assignment document and declaration and power of attorney to Mr. Toshio Tamura to obtain the inventor's signatures. In his signed statement Mr. Tamura merely states that he "personally contacted" inventor Yokoyama and that the inventor refused to sign the documents. As shown above, this evidence is insufficient for granting a petition under 37 CFR 1.47(a). Applicant has not shown that a complete set of the application papers were provided to the inventor prior to the alleged refusal to sign the declaration. In addition, the Tamura statement does not provide any details of the alleged refusal. In order to proceed under 37 CFR 1.47(a) applicant must provide a firsthand account of the presentation of the papers to the nonsigning inventor, as well as, the details of the alleged refusal. Applicant must submit either a copy of a written refusal to cooperate or a statement of facts including time and place if the refusal was communicated orally.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 571-272-3294
Fax: 571-273-0459